

REMARKS

The last Amendment has been carefully considered.

It is noted that claims 13, 14, 16, 17, and 19-27 are rejected under 35 U.S.C. 103(a) over the patent to Savage in view of the patent to Delf.

Claim 28 is indicated as allowable by the Examiner but rejected under 35 U.S.C. 112.

The Examiner's indication of the allowability of claim 28 has been gratefully acknowledged. In connection with this indication, claim 28 has been amended in formal aspects as suggested by the Examiner, and it is believed that the Examiner's grounds for its formal rejection are eliminated and claim 28 should be allowed.

At the same time applicant retained the other claims as they were.

It is respectfully submitted that the new features of the present invention as defined in claim 13, 25, 26 and 27 clearly and patentably distinguish the present invention from the prior art.

Turning now to the references and in particular to the patent to Savage, it can be seen that the patent to Savage does not disclose a one-piece slaving element, neither the slaving element of the patent to Savage is fixed on the drive shaft.

The patent to Delf does not disclose a one-piece spring element since, as explained previously during the prosecution, in this reference it is specifically stated that no direction vibration contact must be provided between the slaving element and the add-on part. The arrangement disclosed in the patent to Delf includes components 37, 25, 36.

If a person skilled in the art designed the slaving element 28 or 42 of the arrangement disclosed in the patent to Savage in correspondence with the teaching of the patent to Delf, it would be impossible to pass it through the corresponding opening 32 in the add-on part. It is therefore believed that the references teach away from one another.

In connection with this, it is believed to be advisable to cite the decision in Gurley, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994) in which it was stated:

"A reference may be said to teach away if a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."

As explained herein above, the references teach divergent concepts and therefore they can not be combined as a matter of obviousness.

The Examiner's statement that the patent to Delf shows a one-piece slaving part, and therefore a combination of the teachings of the patent to Savage and Delf could lead to the applicant's invention can not be considered as justified, since a combination of the teachings of these two references would not directly lead to the applicant's invention. No reasons are presented why such a combination of the references can be obvious. None of the references teaches anything which can provide any hint or suggestion for combining with another reference. The fact that both references deal with the fan mounting is not sufficient to support the statement that they can be combined as a matter of obviousness. The Examiner's opinion that the references are combinable as a matter of obviousness is not supported and can not be considered as correct.

It is first respectfully submitted that if a person skilled in the art familiarized himself with the slaving element disclosed in the patent to Savage, he will not be able to replace it simply with a slaving element disclosed in the patent to Delf. If a person skilled in the art designed the slaving element of the patent to Savage as a one-piece element, then additional conversion features have to be provided which would not necessarily lead the person skilled in the art to the new features of the applicant's invention.

In order to arrive at the applicant's invention from the combination of the references, is such is made for such unknown and highly improbable reasons, a person skilled in the art would have to modify the references by introducing into them the features which were first proposed by the applicant. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references are silent about such modifications.

In summary, it should be said that a simple combination of a slaving element disclosed in the patent to Delf with an arrangement disclosed in the patent to Savage is just not possible. And if such a combination for some reasons was artificially made it would not lead to the applicant's invention.

In view of the above presented arguments, it is believed that the independent claims currently on file should be considered as patentably distinguishing over the art and should be allowed together with the dependent claims.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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